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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/018,144
Filing Date: April 11, 2002.
Appellant(s): LIEDTKE ET AL.

Robert W. Becker
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 21 September 2005 appealing from the Office action mailed 19 April 2005.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claims 51-55 and 62 stand rejected under 35 U.S.C. §102(a) as anticipated Japanese Patent No. 11-126377.

Claims 32-35, 37, 38-41, 43, 44, and 46-50 stand rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent 6,200,402 to Amo in view of Japanese Patent No. 11-126377.

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Claim 36 stands rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent 6,200,402 to Amo in view of Japanese Patent No. 11-126377 and U.S. Patent No. 5,891,290 to Deurer et al.

Claim 45 stands rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent 6,200,402 to Amo in view of Japanese Patent No. 11-126377 and U.S. Patent No. 6,004,420 to Nakamura et al.

Claims 56-59 stand rejected under 35 U.S.C. §103(a) as obvious over Japanese Patent No. 11-126377 in view of U.S. Patent No. 6,004,420 to Nakamura et al.

Claim 60 stands rejected under 35 U.S.C. §103(a) as obvious over Japanese Patent No. 11-126377 in view of U.S. Patent No. 6,004,420 to Nakamura et al. and U.S. Patent 6,200,402 to Amo.

Claim 61 stands rejected under 35 U.S.C. §103(a) as obvious over Japanese Patent No. 11-126377.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 51-55 and 62 rejected under 35 U.S.C. 102(a) as being anticipated by JP 11-126377 (hereafter JP '377).

Regarding claim 51, JP '377 discloses an apparatus for bonding two substrates together including a lamination station for applying a first substrate (101) with a film (112). The station includes a pressure roller (51) with the substrate (101) being advanced linearly past the roller (51) during lamination. The substrate adhering station occurs later and includes a pressure pad (208). (See Figures 1, 5, and 14.) It is the position of the examiner as set forth on pages 8 and 9 of the Final Office Action mailed 19 April 2005, that the apparatus of JP '377 has all the structural features of applicant's claim. The adhesive film set forth in the claim amounts to material worked upon and does not add any structural features to the claim since the apparatus of JP '377 would be capable of handling adhesive film that is adhesive on two sides.

Regarding claims 52, 53, and 62, these claims fail to add any structural limitations to the apparatus claim because they deal with the material worked upon. The apparatus of JP '377 is capable of handling the adhesive film which corresponds to the substrates to be adhered. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex

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parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). (See MPEP §2115.)

Regarding claims 54 and 55, the film (112) in JP '377 is aligned to the substrate by means of guide roller (43) and holder (21). (See Figure 5.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32-35, 37, 38, 40, 41, 43, 44, 46, 48, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amo (US Patent No. 6,200,402 B1) in view of JP '377.

Regarding claim 32, Amo discloses a method and apparatus for laminating disc-shaped substrates. The process includes providing a first substrate (D1) and pressing an adhesive film (S2, S3) onto the substrate via a pressing roller (1), the pressing roller (1) moves relative to the substrate (D1). Next a second substrate (D2) is aligned relative to the first substrate (D1) and the two substrates are joined. (See Figures 2-7, 16, and 17.) Amo does not teach moving the substrate during lamination. JP '377 discloses having the substrate move as a film is pressed thereon. It would have been obvious to one having ordinary skill in the art at the time the invention was made based on the teachings of JP '377 that an obvious alternative to having the pressure roller move past the substrate is to have the substrate move past the pressure roller, because the two actions are functionally

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equivalent alternative expedients. One of ordinary skill in the art would appreciate that they could either move the roller past the substrate or the substrate past the roller, they are equivalent actions and the resulting lamination between the film and the substrate would be the same.

Regarding claim 33, peeler (4) causes the adhesive film to withdraw from the carrier film (S1). (See Figures 8 and 9.)

Regarding claim 34, a protective film (L) is withdrawn from the adhesive film (S2, S3) before it is applied to the substrate (D1). (See Figure 1.)

Regarding claims 35, as can be seen in Figure 20(A), the adhesive film (S2, S3) corresponds to the shape of the substrates.

Regarding claims 37 and 38, the film is applied in a center manner to the substrate by means of a centering shaft (3). The shaft (3) aligns the adhesive prior to the step of pressing the adhesive thereon. (See Figure 3.)

Regarding claim 40, the adhesive film is held above the substrate (D1) prior to the step of pressing the film thereon. (See Figures 10(A) and 10(B).)

Regarding claims 43, 44, and 46, Figure 16 shows a centering and holding device for aligning the substrates where the second substrate (D2) is held apart from the first substrate (D1) before it is pressed thereon.

Regarding claim 48, pressing the substrates together results in an adhesive bond between the two.

Regarding claim 50, a single layer of adhesive film is used.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amo in view of JP '377 as applied to claims 32, 33, and 35 above, and further in view of Deurer et al. (US Patent No. 5,891,290).

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Regarding claim 36, Amo discloses the adhesive film with the corresponding size and shape of the substrate but does not disclose how that film was created. Deurer discloses placing or 'punching' sections (10) cut out from one film (20) onto a carrier film (21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the adhesive film in Amo onto the carrier means by a means similar to that in Deurer, because the embodiment in Deurer is well known in the art. Furthermore, it is within the purview of the artisan to look to a reference like Deurer to determine how the film in Amo is created.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amo in view of JP '377 as applied to claim 32 above.

Regarding claim 39, Amo discloses a laminating roller (1) for pressing the adhesive film onto the substrate body, but does not discuss how much pressure is applied in this step or a means for controlling the amount of pressure used. It would have been obvious to one having ordinary skill in the art at the time the invention was made to control the pressure applied by the laminating roll in Amo, because it is within the purview of the artisan to add a control feature to prevent possible damage that too pressure can cause. Alternatively, if too little pressure is applied, then the film is not applied properly to the substrate and a defective product is created.

Claims 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amo in view of JP '377 as applied to claim 32 above, and further in view of Nakamura et al. (US Patent No. 6,004,420).

Regarding claim 45, Amo does not disclose if the substrates are pressed together in a vacuum or not. Nakamura discloses the prior art apparatus in Figure 16 where the two

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disk substrates (46) are bonded to each other by first bonding the first disk substrate (46) to the adhesive double coated sheet (51) by means of vacuum pressing; then separating a release film (53) by the release film gripping mechanism (49) and inverting the first disk substrate. Then the second disk substrate (46) is bonded, by means of vacuum pressing, to the first disk substrate (46) with the adhesive double-coated sheet (51) stuck thereto. (Col. 1, lines 31-50.) It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a vacuum in the bonding step in Amo, because Nakamura shows that it is well known in the art to bond substrates together in a vacuum. Furthermore, an artisan would know that a vacuum condition would prevent contaminants from interfering with the bonding process.

Claims 47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amo in view of JP '377.

Regarding claim 47, Amo does not discuss how much pressure is exerted with the two steps are bonded together or a method of controlling the pressure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to control the pressure applied by the press (100) in Amo, because it is within the purview of the artisan to add a control feature to prevent possible damage that too pressure can cause. Alternatively, if too little pressure is applied, then the two substrates would not be bonded together properly and a defective product is created.

Regarding claim 49, Amo does not state that the adhesive film is 'hardened', however it is within the purview of the artisan to know that the final result desired in Amo is that the adhesive film be hardened, because a permanent bond results between the substrates in Amo and this cannot be achieved if the adhesive film is 'soft'.

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Claims 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '377 as applied to claim 51 above, and further in view of Nakamura et al.

Regarding claims 56 and 57, JP '377 does not detail the manner in which the substrates are pressed together. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made based on Figure 14 that the substrates are held apart and then pressed together in a centered manner. JP '377 does not disclose if the substrates are pressed together in a vacuum or not. Nakamura discloses the prior art apparatus in Figure 16 where the two disk substrates (46) are bonded to each other by first bonding the first disk substrate (46) to the adhesive double coated sheet (51) by means of vacuum pressing; then separating a release film (53) by the release film gripping mechanism (49) and inverting the first disk substrate. Then the second disk substrate (46) is bonded, by means of vacuum pressing, to the first disk substrate (46) with the adhesive double-coated sheet (51) stuck thereto. (Col. 1, lines 31-50.) It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a vacuum in the bonding step in JP '377, because Nakamura shows that it is well known in the art to bond substrates together in a vacuum. Furthermore, an artisan would know that a vacuum condition would prevent contaminants from interfering with the bonding process.

Regarding claim 58, the prior art in Nakamura discloses a vacuum presser (48) with a hood, base, and a support.

Regarding claim 59, pressure pad (208) in JP '377 is equivalent to a pressure ram.

Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '377 in view of Nakamura et al. as applied in claim 59, further in view of Amo.

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Regarding claim 60, the pressure pad (208) in JP '377 is not detailed as including a centering and holding device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have centering and holding device to achieve the proper substrate bonding. This is shown in Figures 16 and 17 of Amo. No actuating device is disclosed in Amo, but it is inherent that an actuating device exists to achieve the movement shown in the Figures.

Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '377 as applied to claim 51 above.

Regarding claim 61, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include compressed air in the bonding station to assist in the bonding process, because using compressed air could speed up the bonding process and has less chance of harming the substrates than the pressure the ram would place on it.

(10) Response to Argument

Applicant states in the paragraph spanning pages 6 and 7 of the Appeal Brief that the claimed apparatus requires "a lamination station for applying to a first substrate an adhesive film that has adhesive on two sides" and that "JP '377 does not disclose nor even suggest a lamination station capable of applying double-sided adhesive film to substrates." The examiner disagrees with this assertion. The apparatus in JP '377 is capable of handling and laminating a two-sided adhesive film to a substrate. JP '377 includes a film delivery roller (42) which is capable of handling a roll of film which includes a double-sided adhesive film layer. Applicant shows such a roll of film in Figure 2 of the instant application. A recitation of the intended use of the claimed invention must result in a structural difference

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between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim, such is the case here.

In the paragraph spanning pages 7 and 8 of the Appeal Brief, applicant goes into detail regarding the function of the apparatus in JP '377, arguing that all the things done in JP '377, which are not done in the instant invention result in JP '377 not anticipating the claimed invention. Examiner agrees the apparatus in JP '377 is different from the apparatus applicant is disclosing their specification, however, it is the claims which are of interest and while the claims are read in light of the specification, limitations from the specification cannot be read into the claims. Claim 51 consists of a (1) lamination station with a rotatable pressure roller and device for moving a substrate past the pressure roller and (2) an adhering station for joining two substrates together. The lamination station and adhering station are both disclosed by JP '377 in sufficient detail to read on the **claimed** invention as set forth above.

In the paragraph spanning pages 8 and 9 of the Appeal Brief, applicant asserts that the examiner "seeks to take JP '377...and force it into the mold of the Applicant's Claim 51." Applicant's argument centers on the use of case law Ex parte Thibault stating that the case law is distinguishable because it is drawn to a method claim, not an apparatus claim like the instant application. However, applicant has failed to notice that Ex parte Thibault deals with both method and apparatus claims and was used by the examiner because it is contained as case law of interest in §2115 of the MPEP which states specifically that "material worked upon does not limit apparatus claims." Applicant's Claim 51 does not include the adhesive film as part of the apparatus, instead, the adhesive film material worked upon by the apparatus, therefore, if the prior art is capable of handling the film, it meets the claim limitations. It is the examiner's position that the machine in JP '377 is capable of handling a

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capable of handling a double-sided adhesive film. JP '377 includes a film feed roller (42), much like the applicant's feed roller (22) (which is not claimed by the applicant) shown in Figure 2 of the instant application. There is nothing claimed by the applicant which would distinguish their invention over the prior art apparatus in JP '377.

Applicant goes on to argue at the bottom of page 9 that JP '377 teaches away the claimed invention, because JP '377 uses adhesive coaters (11) instead of an adhesive film. Again, adhesive film is not part of the claimed apparatus and as such does not limit the apparatus claim. Furthermore, this argument is drawn to a recitation of the intended use of the claimed invention. Applicant does not identify a structural difference between the claimed invention and the prior art. Given an adhesive film, the apparatus of JP '377 would be capable of performing the intended use, thus it meets the claim.

Regarding the §103(a) rejection using Amo in view of JP '377, in the paragraph spanning pages 11 and 12 of the Appeal Brief the applicant suggests the examiner has fallen victim to the "insidious effect of a hindsight syndrome." It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). All the claimed features are disclosed in Amo in view of JP '377, as is an appreciation that the substrate can move beneath the roller rather than the roller moving over the substrate. This is not knowledge gleaned only from applicant's disclosure. For example, Figure 10 of JP '377 shows an embodiment where the film (112) is pressed onto a substrate using a moving roller (202), thus the concept of moving the roller over a substrate and the concept of moving the substrate beneath the roller are both shown in JP '377.

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In the first paragraph on page 12, applicant states "Claim 32 is not obvious over Amo in view of JP '377 since there is no motivation to modify the teachings of either reference to make the specific combination that was made by the Applicant." In response to the that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, knowledge generally available to one of ordinary skill was relied on as set forth above.

Applicant states on page 13 that there must be "some suggestion, teaching, or motivation in the prior art", arising from what the prior art would have taught a person of ordinary skill in the field of the invention." The examiner maintains the position that since the action of moving the substrate past the roller is a functionally equivalent alternative expedient of moving the roller past the substrate and both are known to an artisan as taught by Amo and JP '377, substituting one for the other would have been obvious to one having ordinary skill in the art at the time the invention was made.

At the bottom of page 13 applicant states that Amo and JP '377 are both in the broad field of the manufacture of optical discs, then goes on to state that JP '377 is in an unrelated area of the field because it teaches applying the adhesive in liquid form instead of film form. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Both references show laminating a film to a substrate, Amo shows the adhesive being on the film and JP '377 shows the adhesive on the substrate onto which a film is laminated temporarily.

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These are equivalent steps and an artisan would be motivated to look to JP '377 to see a different way to laminate the film to the substrate as seen in Figure 5. The fact that the film is laminated to the substrate in JP '377 for a different purpose than what is done in Amo does not prove the combination is nonobvious. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Regarding the §103(a) rejection of claim 36 over Amo in view of JP '377 and Deurer, in the paragraph spanning pages 14 and 15 of the Appeal Brief applicant argues that Deurer is an inappropriate reference because it "in no way suggests any relation to the field of optical disc manufacture." It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the problem of concern is how the sections of adhesive film were placed onto a carrier. This issue is dealt with in Deurer and one of ordinary skill in the art would be motivated to look to the labeling art to deal with placing successive elements on an elongated web, because labels are commonly dispensed that way in labeling machines and then subsequently laminated to an article.

Regarding the §103(a) rejection of claim 45 over Amo in view of JP '377 and Nakamura, on page 16 of the Appeal Brief applicant argues that Nakamura is applied inappropriately and improper hindsight was used, but fails to elaborate on this contention. It must be recognized that any judgment on obviousness is in a sense necessarily a

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reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Nakamura, which is in the applicant's field of endeavor, shows that the joining of the substrates can be done in a vacuum, while Amo is silent on whether they should be joined in a vacuum. An artisan would appreciate there are advantages to joining the substrate in a vacuum and as such would be motivated to use one in Amo in view of JP '377 based on the teachings of Nakamura.

Regarding the §103(a) rejection of claims 56-59 over JP '377 in view of Nakamura, on page 17 of the Appeal Brief applicant argues the examiner has fallen "victim to the insidious effect of a hindsight syndrome" in rejecting claims 56-59 over JP '377 in view of Nakamura. Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but here the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, thus such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Nakamura, which is in the applicant's field of endeavor, shows that the joining of the substrates can be done in a vacuum. JP '377 leaves out details on how the substrates are pressed together, but shows use of a presser (208) in Figure 14. An artisan would appreciate there are advantages to joining the substrate in a vacuum and as such would be motivated to use one in JP '377 based on the teachings of Nakamura.

In the paragraph spanning pages 18 and 19 of the Appeal Brief, applicant states "Claim 51 is not obvious over JP '377 in view of Nakamura." This is true. JP'377 as set forth above anticipates claim 51. Nakamura was relied on for claims 56-59 which depend

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from claim 51. Applicant goes on to state the examiner has not referenced any suggestion, teaching or motivation for combining the prior art for the combination. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, knowledge generally available to one having ordinary skill in the art was used. An artisan would appreciate that are advantages to bonding substrates in a vacuum chamber and would use a vacuum chamber as taught by Nakamura if they so choose.

In response to applicant's argument on page 19 that the references are somehow nonanalogous art because JP '377 is in an "unrelated area of the field of the proposition asserted" in Nakamura, since JP '377 distributes adhesive in liquid form, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, they are closely enough related to make the use of JP '377 and Nakamura together appropriate. Furthermore, JP '377 teaches glue (201) being transferred from a film (112) and thus not always in liquid form as suggested by the applicant.

Applicant goes onto argue on page 19 that they are unclear how the laminating station functions, in particular "whether during the laminating process the substrate is moved by a device past a pressure roller and is moved parallel to the surface of the substrate—as required by the elements of Applicant's independent Claim 51." Claim 51

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requires "a laminating station for applying to a first substrate an adhesive film that is adhesive on two sides" the "laminating station comprises a rotatable pressure roller and a device for moving said first substrate linearly past said pressure roller during lamination" where "such movement extends parallel to a surface of said first substrate." Figure 5 of JP '377 clearly shows these structural limitations. The lamination station of JP '377 shows a roller (51) and a device (21) which moves a substrate (101) past the pressure roller. Applicant's argument amounts to intended use and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The apparatus of JP '377 is capable of moving the substrate past the pressure roller and the movement is parallel to the surface of the substrate as shown in Figure 5(c), thus JP '377 meets the claimed limitations. "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

Applicant argues at the bottom of page 19 and onto page 20 that JP '377 never discloses a laminating film. However, JP '377 does use a laminating film and while the film is not exactly the type of film used in applicant's specification, claim 51 does not set forth the film as part of the apparatus, thus the film is merely material worked upon and does not further limit the apparatus claim.

Regarding the arguments on pages 20 and 21 of the Appeal Brief, applicant's statement that Claims 60 and 61 are rejected under §103(a) over Amo in view of JP '377 and Nakamura is inaccurate. As shown on pages 7 and 8 of the Final Rejection mailed 19 April 2005, Claim 60 stands rejected under §103(a) as obvious over JP '377 in view of Nakamura and Amo and Claim 61 stands rejected under §103(a) as obvious over JP '377.

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Why the combination is appropriate for claim 60 is dealt with sufficiently above and will not be reiterated here. Applicant fails to argue the §103(a) rejection of claim 61 over JP '377.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Sue A. Purvis



Conferees:

Chris Fiorilla *CF SPE AU 1734*

Steve Griffin *SPM SPE AU 1731*